

disclosure of Gokcebay to have mounted the nitinol wire 40 and lever 42 of Aston Fig. 4 inside the plug. This ground of rejection has been again carefully reviewed and again must be traversed. In particular, there exists no suggestion within the four corners of the Gokcebay reference from which one of ordinary skill in the art would have been motivated to make the modification proposed by the Office action.

The Examiner relies on "the reasons set forth" in Gokcebay as such motivation. In this regard, Gokcebay states that the object of his invention is to provide a system "which avoids the need for electronics, solenoids or other hardware which would take up space within the coin box or the lock casing adjacent to the lock." Col. 2, ll. 52-55. Gokcebay specifically references U.S. Patent No. 5,140,317 as a system that "requires additional hardware within the lock casing or the coin box for blocking the opening of the lock."

In accordance with the stated objective, Gokcebay provides a lock "which occupies no more space than the mechanical lock itself." While the disclosed embodiment of Gokcebay contains a solenoid and retractable pin in the plug, there is no teaching of any specific benefit of "housing the electronic access feature of a lock cylinder in the mechanical lock plug itself" as asserted in the Office action.

Turning now to the disclosure of Aston, it is seen that in the embodiment of Fig. 1 as well as the embodiment of Fig. 4, all of the electronics, solenoids and other hardware are located within the lock cylinder 10. As such, the Aston device already satisfies the stated objective of the Gokcebay reference, wherein "[n]othing is required outside the lock cylinder."

Thus, there exists in the Gokcebay reference no stated improvement, advantage or particular purpose to be served from which one of ordinary skill in the art would have made the modification proposed in the Office action. To the contrary, the only suggestion for making such a modification comes from the present application.

While it is true that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference, neither is obviousness established where it is shown that a person of ordinary skill in the art would be able to make the proposed combination or would know how to implement the proposed modification. Instead, there must exist some reason within the prior art as a whole for the person of ordinary skill in the art to have made the proposed combination. The reason, suggestion or motivation can not come from the applicant's invention itself.

In re Oetiker, 24 USPQ2d 1443 (Fed. Cir. 1992).

In summary, while one of ordinary skill may have been able to modify the Aston device so that the components could be incorporated into the plug, there exists no reason or motivation in the prior art from which the skilled person would have been led to do so, since the Gokcebay reference does not teach any improvement or advantage to be achieved beyond what is already disclosed by Aston.

In view of the foregoing, further and favorable reconsideration of this application, withdrawal of the outstanding grounds of rejection and the issuance of a Notice of Allowance are earnestly solicited.

Please charge any fee or credit any overpayment pursuant to 37 CFR 1.16 or 1.17 to Deposit Account No. 02-2135.

Respectfully submitted,

ROTHWELL, FIGG, ERNST & KURZ, p.c.

By Vincent M DeLuca  
Vincent M. DeLuca  
Attorney for Applicants  
Registration No. 32,408

555 Thirteenth Street, N.W.  
Suite 701 East Tower  
Washington, D.C. 20004  
Telephone: (202) 783-6040